

REMARKS

I. TRAVERSAL OF RESTRICTION AND ELECTION OF SPECIES

The restriction/election of species requirement is traversed on the grounds that assertions that the inventions of Groups I and II (method of controlling or eliminating external parasites); Group V (process of making) and Groups VI-IX (product) are distinct. However, a restriction/election of species requirement must also indicate why the inclusion of multiple invention represents a burden to the office (see MPEP 803 - "If the search and examination of an entire application can be made without serious burden, *the examiner must examine it on the merits*, even thought it includes claims to independent or distinct inventions.").

Given that the method of use claims use the same or substantially similar products and process claims make the products claimed in Group VIII, the same search used for the claims of Group VIII would also be used in the search for the method of use and process of making claims of Groups I, II and V. In addition, there is no indication from the Image File Wrapper that even a cursory search of the prior art has been made and as such any assertion of undue burden is purely speculative. Therefore, there is no basis which supports that it would be an undue burden on the office to examine the claims of Groups I, II and V.

Even if additional support for an undue burden was later presented and this restriction/election of species is maintained, the applicants note the method of use claims 29-43 are directly or indirectly linked to claim 1. MPEP 809.03 "Linking Claims" states: "The most common types of linking claims which, if allowed, act to prevent restriction between inventions that can otherwise be shown to be divisible, are

- (A) genus claims linking species claims;
- (B) a claim to the necessary process of making a product linking proper process and product claims;
- (C) a claim to "means" for practicing a process linking proper apparatus and process claims; and
- (D) a claim to the product linking a process of making and a use (process of using)."

Type (D) most closely resembles the claims of the invention. As such, the Examiner is reminded that MPEP 809 states in part that "[t]he *linking claims must be examined with*

the invention elected, and should any linking claim be allowed, the restriction requirement must be withdrawn." (emphasis added)

Lastly, MPEP 821.04 (Rejoinder) states in part that "Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called under 35 U.S.C. 121 to elect claims to either the product or the process. See MPEP § 806.05(f) and § 806.05(h). The claims directed to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP § 809.02(c) and § 821 through § 821.03. *However, if an applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.*" (emphasis added)

In summary, the claims of Groups I, II and V have not been shown to represent an undue burden on the Office, the claims of Groups I, II and V and Group VIII are linked and the claims of Groups I, II and V would be rejoined with the claims of Group VIII when the latter claims are allowed. For any of these reasons, the restriction/election of species requirement should be withdrawn and all the claims should be examined on the merits.

II. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-36 are now pending in this application. Claims 26-29, 33, 35 and 36 are subject to examination based on the elections with traverse by the applicants. Claims 1-25, 30-32 and 34 are withdrawn although the applicants believe that claims 1-7 should also be included in the examination or should be rejoined when the examined claims are allowed.

Claims 1, 6, 8, 15, 19, 26, 30 and 33 have been amended to correct minor typographical errors. No new matter has been added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

CONCLUSION

In view of the above, reconsideration and withdrawal of the restriction requirement is respectfully requested. Early and favorable consideration of the application on the merits, and early Allowance are earnestly solicited.

The Commissioner is hereby authorized to charge any additional fee which may be required, or credit any overpayment to Account No. 50-0320.

Respectfully submitted,
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